REMARKS/ARGUMENTS

Claims 1-5, 8-18, 21-32, 35-46, 49-56 and 59-80 are pending in this application. Claim 81 has been canceled. Claims 1, 14, 27, 41, and 55 are independent claims.

Claim Rejection 35 U.S.C. § 103

35 U.S.C. § 103(a)

When applying 35 U.S.C. §103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc.,* 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Claims 1-5, 8-18, 21-32, 35-46, 49-56, 59, 61-62, 64-65, 67-68, 70-71 and 73-79 and 80-81 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik et al. ("Malik", U.S. Patent Number 6,023,701) in view of Schmid ("Schmid", Web Representation with Dynamic Thumbnails) and Brown et al. ("Brown-2", U.S. Patent Number 6,278,448). Claims 60, 63, 66, 69, and 72 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik in view of Schmid and Brown-2 and further in view of Gennaro et al. ("Gennaro", U.S. Patent Number 5,742,768). Applicant respectfully traverses these rejections.

Independent Claims 1, 14, 27, 41, and 55 include an element of "generating a representation of said linked second site, the representation not being a hyperlink." (emphasis added). In rejecting Claims 1, 14, 27, 41, and 55, the Patent Office indicated that Malik "teaches ... generating and communicating a listing of hyperlinks of linked sites for presentation to the user (col. 2, lines 27-40)." (emphasis added) (Office Action, pages 2-3). Further, the assertion that Malik teaches generating and

communicating a list of hyperlinks of linked sites for presentation to the user is further support by the Malik abstract stating "a method and implementing computer system is provided in which an internet or web network user may invoke a hyperlink or site link listing mode to retrieve only the hyperlink..." (Malik, US 6,023,701, Abstract). However, this is not the presently claimed invention. The "representation of said linked second site" element as claimed in Claim 1 is "a graphical image of the indicative of content of said linked second site." That is, the "representation" element as claimed in Claim 1 is not the hyperlink itself as disclosed in Malik. The assertion that the representation is not a hyperlink is supported throughout the specification of the present application. For example, "[r]eferring now to FIG. 1 ... A user may access a site 10 containing a link 20 to another site 30, such as a web site or page. To preview the linked site 30, a representation 22 of the linked site 30 may be generated and communicated to a user in the display of the site 10, in this example displayed proximally to the link 20" (emphasis added) (Specification, page 5, lines 12-20). As shown in FIG. 1 of the present application, the representation 22 of the linked site 30 is clearly separate from the link 20 and cannot be the link 20 itself. In addition, "[a]s shown in FIG. 3, representations may be generated by identifying descriptive information contained in the link, linked site tag, etc. For example, if a weather link 342 was identified, a weather representation 332 may be displayed" (emphasis added) (Specification, page 7, lines 16-19). As shown in FIG. 3 of the present application, the weather representation 332 is clearly separate from the weather link 342 and cannot be the weather link 342 itself. In addition, Malik clearly states that "only hyperlinks" are retrieved from the target pages. (Malik, US 6,023,701, Abstract). In contrast, the present invention as claimed includes a representation which is not a hyperlink. Thus, Malik not only fails to teach or suggest the element of "generating a representation of said linked second site, the representation not being a hyperlink," but teaches away from the present invention.

Thus, Applicant respectfully submits that Malik fails to teach, disclose or suggest the element of "generating a representation of said linked second site, the representation not being a hyperlink" as recited in Claims 1, 14, 27, 41, and 55.

Moreover, independent Claims 1, 14, 27, 41, and 55 recite an element of "periodically updating the stored representation of said linked second site by at least one of the linked second site and the first site." (emphasis added). In rejecting Claims 1, 14, 27, 41, and 55, the Patent Office correctly notes that "Ma[l]ik and Schmid do not disclose the updating to take place periodically and the representation to be a stored representation" (Office Action, page 3, line 11). Then, the Patent Office asserts Brown-2 to correct the defects found in Malik and Schmid. (Office Action, page 3, lines 11-13). However, Brown-2 fails to correct these defects.

First, Brown-2 "provides a mechanism for creating or customizing a user interface composite desktop by selecting various components and adding them to a desktop" (emphasis added) (col. 4, lines 12-14). Col. 1, lines 19-34 of Brown-2 recites:

> Prior art GUI desktops have represented such 'entry points' with icons, each of which typically fits a strict form factor (e.g., 32.times.32 pixels and a line or two of text). This type of representation does not scale well to the variety of resources on the World Wide Web, since it is limited in size, strict in form factor, and static (unchanging). The invention described here is designed to provide a way for a GUI desktop to more adequately provide 'entry points' to Internet resources (primarily, HTML-based Web pages); these 'entry points' scale better to Web pages because: a) they can be any size (customizable by user OR by the Web author); b) the representation is not strict, and so, for instance, instead of a static icon the entry point can be used to show a 'preview' of the Web pages they point to; and c) the representation is not static but can instead change over time to reflect the changing nature of the resource (e.g. Web page) (emphasis added).

Thus, even though "the representation" of Brown-2 may be a representation of a Web page, "the representation" of Brown-2 is still part of a GUI desktop. In other words, Brown-2 attempts to establish a link between an icon of a GUI desktop and a Web page, *not* a link between two Web pages. As previously argued, this is different from Claim 1 where "a first site ... at least one of a link and a second site linked to said first site ... a representation of said linked second site" (emphasis added) is recited.

Further, "the representation" of Brown-2 is a representation of a site, *not* "a representation of said linked second site" (emphasis added) recited in Claim 1. Brown-2 does not have a second site so it cannot teach or suggest "periodically updating the stored representation of said linked second site" as presently claimed. Thus, the combination of Matik, Schmid, and Brown-2, fails to teach, disclose or suggest "periodically updating the stored representation of said linked second site by at least one of the linked second site and the first site," as recited in Claim 1.

Therefore, the combination of Matik, Schmid, and Brown-2, on the whole, fails to teach the present invention as claimed. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Emphasis added. Removal of the pending rejection under 35 U.S.C. §103(a) to Claims 1-5, 8-18, 21-32, 35-46, 49-56, 59, 61-62, 64-65, 67-68, 70-71 and 73-79 and 80-81 is respectfully requested and allowance is earnestly solicited.

In addition, Claims 60, 63, 66, 69, and 72 include all claim limitations as applied in Claim 1 as well as the limitation of a pop-up menu. As correctly stated by the Patent Office, "the representation of the method of Matik, Schmid, and Brown-2 is not taught to be a pop-up menu." (Office Action, page 6, lines 18-19). The Office then asserts Gennaro to overcome the present defect. Although the Patent Office is employing Gennaro for teaching the representation to be a pop-up menu, Gennaro does not teach or suggest "the representation being a graphical image indicative of content of said linked second site" or "periodically updating the stored representation of said linked second site" which are also lacking from the combination of Matik, Schmid, and Brown-2. Instead, Gennaro teaches "a method for providing a web page having an embedded menu to a web browser and for displaying the web page to a user of the web browser." (Gennaro, Abstract). Thus, the combination of Matik, Schmid, Brown-2, and Gennaro, on the whole, fails to teach the present invention as claimed. Removal of the pending rejection under 35 U.S.C. §103(a) to Claims 60, 63, 66, 69, and 72 is respectfully requested and allowance is earnestly solicited.

CONCLUSIONS

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Respectfully submitted,

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